UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARIA DOLORES MARTINES-SERNA VILLAGRAN,
EILEEN MARIE BOYLE and MARKO STOJANOVIC

Appeal No. 2005-2462
Application No. 09/906,977

ON BRIEF

Before KIMLIN, JEFFREY T. SMITH and PAWLIKOWSKI, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-8.

Claim 1 is illustrative:

1. Dehydrated potato products made by the method comprising:

(a) cooking potatoes to a hardness of from about 65 gf to about 500 gf to form cooked potatoes;

(b) comminuting the cooked potatoes to from a wet mash;

(c) dehydrating the wet mash to form dehydrated potato products.

The examiner relies upon the following reference in the rejection of the appealed claims:

Martines-Serna Villagran (Villagran) 6,066,353 May 23, 2000

Appellants' claimed invention is directed to dehydrated potato products made by the recited steps for cooking, comminuting, and dehydrating. The potatoes are cooked to a hardness of about 65 gf to about 500 gf. According to appellants "[t]he dehydrated products can be used to produce food products having improved potato flavor and improve texture" (page 2 of the brief, second paragraph).

Appealed claims 1-8 stand rejected under 35 U.S.C. § 103(a) being unpatentable over Villagran.

Appellants do not provide separate arguments for claims 4-8. Accordingly, claims 4-8 stand or fall together with claim 1.

We have thoroughly reviewed each of appellants' arguments for patentability. However, we find that the examiner's rejection is well-founded and in accordance with current patent jurisprudence. Accordingly, we will sustain the examiner's rejection.

Villagran, like appellants, discloses a method of making dehydrated potato products by comminuting cooked potatoes to form a wet mash and dehydrating the mash to form a potato product. As recognized by the examiner, and urged by appellants, Villagran does not disclose cooking the potatoes to a hardness in a range of about 65 gf to about 500 gf. Indeed, Villagran is totally silent regarding the hardness of the cooked potato. However, it is well settled that when a claimed product reasonably appears to be substantially the same as a product disclosed by the prior art, the burden is on the applicant to prove that the prior art product does not necessarily or inherently possess characteristics contributed to the claimed product. In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990); In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). This principle of patent law also applies to product-by-process claims, the format in which the presently appealed claims are drafted. See In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). In re Brown, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972); In re Pilkington, 411 F.2d 1345, 1348, 162 USPQ 145, 147 (CCPA 1969).

In the present case, there is sufficient correspondence between the method of making the dehydrated potato products disclosed in appellants' specification and the method disclosed by Villagran to place upon appellants the burden of establishing that there is, in fact, a patentable distinction between dehydrated potato products within the scope of the appealed claims and such products fairly disclosed by Villagran, particularly in light of the rather broad range of hardness claimed. For instance, while both appellants and Villagran disclose that the cooking time is dependant upon a variety of factors, including the amount of potato pieces being cooked, both appellants and Villagran teach cooking essentially the same size potato pieces for about 30 minuets (see appellants specification at page 11, line 9 and Villagran at column 5, line 29). Also, both appellants and Villagran disclose other physical properties of the dehydrated potato that are the same. For example, the present specification discloses that "[t]he potato flakes of the present invention have less than about 70% broken cells" (page 17, line 1), while Villagran discloses that "[t]he dehydrated potato flakes of the present invention comprise from about 40% to

about 60% broken cells (column 7, lines 64-65). In addition, appellants' specification discloses that "[t]he potato flakes comprise from about 5% to about 14%, preferably from about 5% to about 12%, more preferably from 6% to about 9%, and still more preferably from about 7% to about 8% moisture" (page 17, lines 10-12). Significantly, Villagran discloses the same moisture content of "preferably about 6% to about 9%, and more preferably from about 7% to about 8% moisture" (column 8, lines 44-46).

Accordingly, based on the general correspondence between the physical properties for the dehydrated flakes of appellants and Villagran, we find that it is reasonable to place upon appellants the burden of establishing a patentable distinction between the presently claimed product and that disclosed by Villagran. This is eminently fair because the USPTO does not have the facilities and wherewithal to test prior art products, and it is particularly fair and reasonable in the present case inasmuch as both appellants and Villagran share the same assignee, the Proctor and Gamble Company. It would seem that no one is in a better position than appellants to place on this record the

actual gf hardness values of the dehydrated potato products fairly taught by Villagran. Unfortunately, appellants have bought no such evidence to our attention.

We also concur with the examiner's reasoning that the hardness of the dehydrated potato products is a result effective variable that would have been obvious for one of ordinary skill in the art to optimize within the course of routine experimentation. As noted by the examiner, appellants have not proffered any objective evidence that dehydrated potato products within the scope of the appealed claims are unexpectedly superior to the dehydrated potato products fairly taught by Villagran. This lack of evidence also applies to the process steps recited in claims 2 and 3. As set forth by the examiner, appellants have not demonstrated that the claimed final product, prepared by adding 0.5% to about 50% wheat starch to the wet mash before dehydrating, is patentably distinct from the dehydrated products of Villagran. Again, it would not seem to place an undue burden on appellants to place of record any evidence which distinguishes the claimed and prior art products.

In conclusion, based on the foregoing, the examiner's decision rejecting the appealed claims is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED

EDWARD C. KIMLIN Administrative Patent Judge	)	
JEFFREY T. SMITH Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
BEVERLY A. PAWLIKOWSKI Administrative Patent Judge	)	

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